

REMARKS

The applicant notes that the application is a national stage application originating in the United States. The Office relies upon 35 USC 121 as invoked by 35 USC 371 (see below).

(a) All questions of substance and, within the scope of the requirements of the treaty and Regulations, procedure in an international application designating the United States shall be determined as in the case of national applications regularly filed in the Patent and Trademark Office.

(b) In case of international applications designating but not originating in, the United States -

(1) the Director may cause to be reexamined questions relating to form and contents of the application in accordance with the requirements of the treaty and the Regulations;

(2) the Director may cause the question of unity of invention to be reexamined under section 121 of this title, within the scope of the requirements of the treaty and the Regulations; and

(3) the Director may require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English.

35 USC 371(a) limits USPTO procedural actions to those authorized under the PCT and substantive requirements for patentability. 37 USC 371(b) specifically does not apply to this case as it originated in the United States Receiving Office and designated the United States. No lack of unity of invention is alleged by the Office in the International Phase of this application, and no reexamination of unity of invention is authorized by the treaty or section 371. In the Office Action to which this is a response, the Office provides no grounds for determining that there is a lack of unity, beyond the allegation that an apparatus and a process are not permitted combination of categories. This is contradicted by 37 CFR 1.475 (b)(4) "A process and an apparatus or means specifically designed for carrying out the said process. . . ."

The applicant therefore suggests that this is an improper requirement and respectfully requests that the Office withdraw this requirement.

Should the Office refuse to withdraw its improper requirement, the Applicant makes the following election:

The Office, in the action to which this is a response has required restriction between the process of claims 1-9, the apparatus of claim 10-13, and the apparatus of claims 14-20. The Office alleges that no "single, general, inventive concept" exists and cites in support of contention the International Search Report and in particular, US Publication No. 2004/00006424 as "prior art". The Applicant respectfully disagrees with this requirement and is confident that the Office, when it has examined the application will find the '424 reference only generally relevant to patentability of the claims of the present invention. (As, indeed, was the determination of the International Search Authority, classifying all the cited references as "A" references). To make a negative determination of the patentability at this premature stage, before even the Examiner's search (see Image File Wrapper), raises suspicions of prejudice against this application, inconsistent with the Office's typically high standards for fairness. The applicant respectfully submits that attempts to restrict based upon citation of prior art is inequitable and contrary to the Office practice, effectively denying the applicant due opportunity to respond without unnecessarily restricting the scope of potential claims before an examination of the merits of the case. The applicant, however, elects species IIB corresponding to claim 14-20 **without** traverse so as to preserve right to address substantive patentability, without coerced estoppel, at a point in prosecution when the Office has had the opportunity to search, and to examine the claims substantively.

The Office further requires restriction between single combinations of filters. Again this requirement is in violation of 35 USC 371 and PCT Section 13.2. 35 USC 371 provides no authority for the office to make a restriction in this case beyond that authorized by the PCT. The Sect 13.2 of PCT specifically refers to "Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of

the claimed inventions, considered as a whole, makes over the prior art.” The Office makes a restriction between disclosed “species”. The alleged species appears only in claims 8, 13, and 17, not in claim 1-20 to which the Office alleges it applies. In claims 8, 13, and 17, the variable gain filter and constant gain filter are claims as part of a Markush group. The applicant respectfully notes that no preference is expressed regarding variable v. constant gain in the specification. The Office alleges for its rational that the required election would “facilitate examining due to the broad range of embodiments that can be included as applicant’s tracking method/ system”. The Applicant respectfully submits that this is an invalid grounds for a finding of a lack of unity. The convenience of the Office is not the grounds for the establishment of the restriction and unity practices, but the Constitutional requirement to grant only a patent for a single invention. Here the Office alleges not that there are multiple inventions, but that it would “facilitate” examination if the applicant would amend its claims to limit the invention before the Office examines the applications. While the applicant appreciates that the Office’s work load is substantial, but protests strongly that it should not be made to unjustly suffer as a result. The applicant respectfully requests that the Office withdraw it requirement to restrict between these claims as incompatible with PCT 13.2.

The applicant respectfully **traverses** this requirement and respectfully submits that the variable and constant gain filters are not patentably distinct from each other. The Applicant, subject to the requirement to conditionally elect on species withdraws claim 17 from consideration and conditionally elects prosecution of claims 14-6, 18-20 as related to variable gain filters.

Applicant believes the above amendments and remarks to be fully responsive to the Office Action, thereby placing this application in condition for allowance. No new matter is added. Applicant requests speedy reconsideration, and further requests that Examiner contact its attorney by telephone, facsimile, or email for quickest resolution, if there are any remaining issues.

Respectfully submitted,

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